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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/414,483	10/08/1999	MEHO KARALIC	247P1US	3348

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CANADA

EXAMINER

HORTON, YVONNE MICHELE

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 10/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/414,483

Applicant(s)
MEHO KARALIC

Examiner
YVONNE M. HORTON

Art Unit
3635



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 14, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-42 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-26, 28-34, 36-39, and 42 is/are rejected.
- 7) ☒ Claim(s) 27, 35, 40, and 41 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Withdrawal of Previously Indicated

Allowable Subject Matter

1. The indicated allowableness of claims 24-26 and 28 is withdrawn in view of the newly discovered reference(s) to LONGENECKER. Rejections based on the newly cited reference(s) follow.

Claim Objections

2. The numbering of claims of the amendment submitted 8/14/03 is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 29-46 have been renumbered 29-44.

3. Currently, renumbered claim 41 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Renumbered claim 41 depends

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upon itself. For examination purposes and until further clarification, claim 41 has been considered as being dependent upon claim 40.

4. Claim 24 is objected to because of the following informalities: In claim 24, line 3, "lumbar" should be --lumber--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 36 recites the limitation "said flanges" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #451,596 to LONGENECKER. LONGENECKER discloses the use of a combination building structure (as shown in Figures 1 and 2) including a vertical length of lumber (A,C), a horizontal length of lumber (B), a metal corner connector (as shown in Figure 4) including an intermediate portion (K), at least one lateral flange (LF), see the marked attachment, and an upwardly vertical flange (L); wherein, the vertical (A,C) and horizontal (B) lengths abut in face-to-face contact with the intermediate portion (K), the vertical flange (L) and the lateral flanges (LF). In reference to claim 25, the intermediate portion (K) is box-shaped. Regarding claim 26, the lateral flange (LF), although on is shown in the figures, extend horizontally on opposing sides of the intermediate portion (K).

10. Claim 28 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #451,596 to LONGENECKER. LONGENECKER discloses the use of a corner connector, as shown in Figure 4, including an intermediate portion (K), at least one lateral flange (LF), see the marked attachment, and an upwardly vertical flange (L) that extends upwardly from the intermediate portion (K).

11. Claims 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #4,292,775 to HOWARD. Regarding claims 37, HOWARD inherently discloses the method of forming a building component including the steps of connecting lengths of lumber (14,16,22) to form a frame having an opening (O), see figures 1 and 2 and the marked attachment; providing a

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foam material (24) with the openings (O); applying a composite material (27) on one side of the frame and foam (24); allowing the material (27) to solidify and adhere, column 2, lines 33-36 to the frame (14,16,22), foam (24) to thereby reinforce the structure (10). In reference to claim 38, the composite material (27) of HOWARD is plaster which is known to have fibers therein. Regarding claim 39, the method further includes placing a mesh (20) over the frame (14,16,22), column 2, lines 33-36, and applying the composite coating (27).

Claim Rejections - 35 USC § 103

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 29-34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #4,292,775 to HOWARD in view of GINSITE ®. HOWARD discloses the use of a building component (10) including a rectangular frame formed by lengths of lumber (14,16,22) to define an opening (O); wherein only a portion is shown by HOWARD. The opening (O) of HOWARD is provided with foam material (24) such that a reinforced skin (27) of a solidified composite material - plaster, is adhered to the lengths of lumber (14,16,22), over the opening (O), and foam material (24), column 2, lines 33-36, to thereby reinforce the building component (10). Although HOWARD does not explicitly detail the use of a "solidified composite", composites of this type are commonly known as cement of various mixtures. However, GINSITE ® is a commonly recognized "solidified composite" Trademark material. Hence, it

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would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the structure of HOWARD with the "solidified composite material" of GINSITE ® in order to provide the structure with a lightweight, durable and water resistant exterior covering that is also high strength and attractive in appearance. Regarding claim 30, the reinforced skin (27) of HOWARD extends over one side of the frame. In reference to claim 31, the reinforced material (27) overlaps and adheres to the frame periphery, column 2, lines 33-36. Regarding claim 32, HOWARD only shows his reinforced skin (27) being on one side. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made that since the structure of HOWARD is a simple wall structure, this very same wall structure could be used for interior walls also. In this event, both sides of the wall could have the reinforced skin (27). In reference to claim 33, the composite material (27) of HOWARD is plaster and is reinforced with fibers, as is GINSITE ®. Regarding claim 34, the reinforced material (27) of HOWARD includes a mesh (20). In reference to claim 36, HOWARD has flanges 918) that extend between pair of lumber lengths (14,16).

14. Claims 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #4,292,775 to HOWARD in view of US Patent #6,047,518 to LYTLE. Regarding claim 42, HOWARD inherently discloses the method of forming a building component including the steps of connecting lengths of lumber (14,16,22) to form a frame having an opening (O), see figures 1 and 2 and the marked attachment; providing a foam material (24) withing the openings (O); applying a composite material (27) on one side of the frame and foam (24); allowing the material

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(27) to solidify and adhere, column 2, lines 33-36 to the frame (14,16,22), foam (24) to thereby reinforce the structure (10). HOWARD discloses the basic claimed method except for his foam material being “injected”. Injecting a composite material between two members is old and very well known in the art. LYTLE teaches that it is known in the art to “inject” by spraying a composite material (9) between two wood frame members (17,19). Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of HOWARD to employ the step of injecting, as taught by LYTLE, in order to ensure that the composite material covers all of the intended members and proper provides reinforcement thereto. In reference to claim 43, the composite material (27) of HOWARD is plaster which is known to have fibers therein. Regarding claim 44, the method further includes placing a mesh (20) over the frame (14,16,22), column 2, lines 33-36, and applying the composite coating (27).

Allowable Subject Matter

15. Claims 27,35,40 and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Response to Arguments

16. Applicant's arguments filed 8/14/03 have been fully considered but they are not persuasive.

In regard to the applicant's argument that the structure of HOWARD is not the same as the instant applicant because the finish layer is plaster and it is not provided within the frame, the figures clearly depict the plaster (27) being applied "within" the frame. Further, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the composite being applied "within" the frame) are not recited in the rejected claim(s). The claim calls for the composite to be applied in the opening and not specifically the frame. Within is defined as being included as a limit thereof. Surely, the plaster of HOWARD is included as a limit of the framed structure. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the applicant's argument that the plaster of HOWARD is weak and requires a mesh, the instant application also requires the use of a mesh. Hence, the applicant has not provided any substantial difference between the plaster of HOWARD and the instant application. Further, the claims does not specify any required strength associated with the composite material. Also, the claims have been modified by GINSITE®, a Trademark that clearly exhibits strength without the requirements of a meshed material.

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In response to the applicant's argument that the plaster of HOWARD is a finish material that requires a mesh and cannot possibly be used as a reinforcing member, the examiner agrees in part in that the material is a plaster finishing layer. However, HOWARD clearly details that his layer uses a reinforcement (20) which inherently supports the position of the plaster being used a reinforcement, column 2, lines 33-36 and 39.

Regarding the applicant's argument that the composite material of HOWARD does not "adhere" to the lumber, HOWARD, column 2, lines 33-36 surely details the composite as "adhering".

In reference to the applicant as a plaster not being able to be regarded as a reinforcement layer, plaster in combination with a mesh is surely a "reinforcing layer" However, plaster alone can also be a reinforcing layer. How and the amount that something is reinforced is the discerning factor. On face value, clearly the plaster, of HOWARD, even alone "reinforces" the structure to some degree.

Regarding the arguments to GINSBERG, the rejections to the claims have been modified to exclude GINSBERG. Hence, any arguments to GINSBERG are deemed moot.

In response to the applicant's argument that GINSITE ® does not detail any frame structure, GINSITE ® is used to teach the use of composite materials and not the frame structure. GINSITE ® was used to support the position that composite materials, in addition to plaster, are old and very well known in the art.

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In reference to the applicant's argument that HOWARD does not teach the method of the instant applicant in that HOWARD because the claims call for the foamed material to be "injected", only claim 44 (renumbered claim 42) calls for "injection" of the foamed material. In fact the claim 37 merely call for "providing" a foamed material and clearly HOWARD "provides" a foam material (24). The rejection to claim 44 has been modified accordingly.

HOWARD equivalently discloses the device as claimed in the instant application, a wood frame having openings to receive foamed material; wherein, a mesh and composite material are applied thereon to reinforce the structure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (703) 308-1909.

YMH

Primary Examiner

October 28, 2003

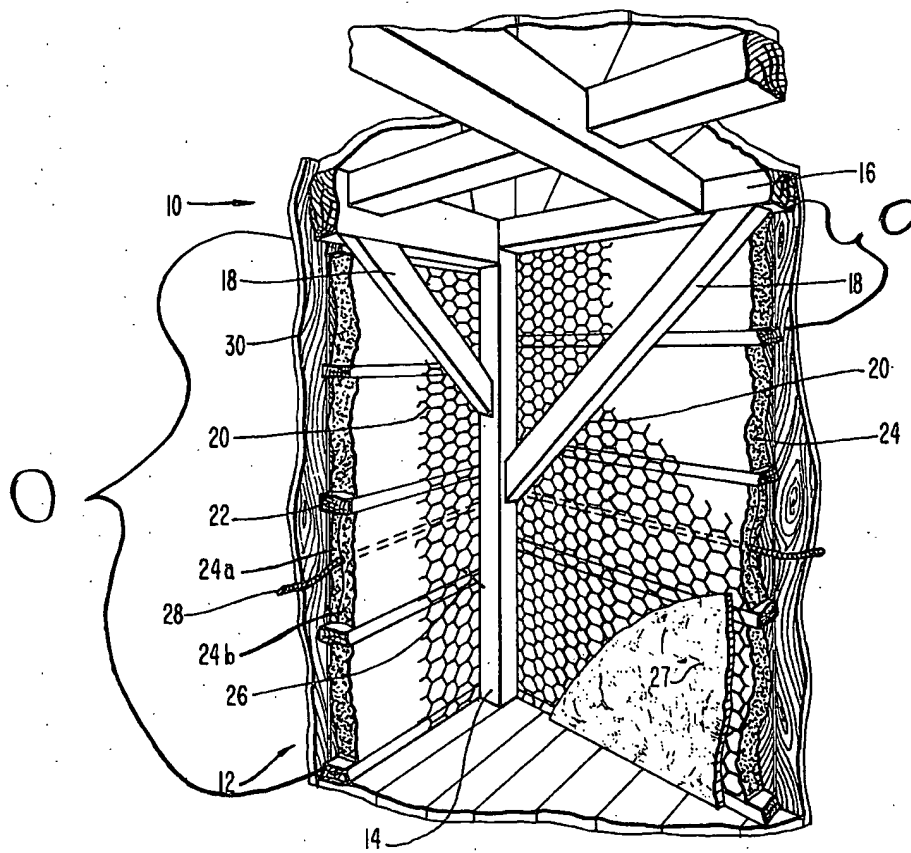


FIG. 1

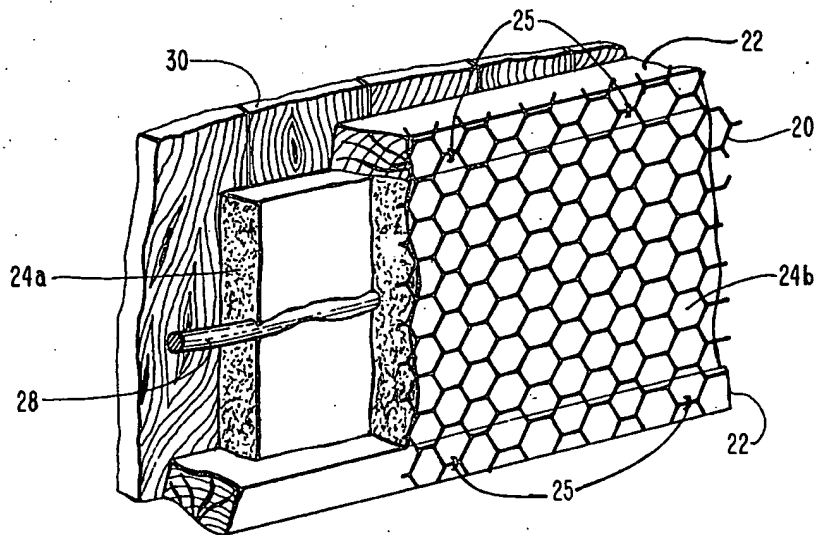


FIG. 2